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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,698	07/09/2003	Daniel A. Collins	217.1010.01	1583
78037 7590 01/25/2010 KALEIDESCAPE, INC. 440 POTRERO AVE. SUNNYVALE, CA 94085-4117				
EXAMINER				
BAUM, RONALD				
ART UNIT		PAPER NUMBER		
2439				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATENTS@KALEIDESCAPE.COM

Office Action Summary

Application No.

10/616,698

Applicant(s)

COLLENS ET AL.

Examiner

RONALD BAUM

Art Unit

2439

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-64 is/are pending in the application.
- 4a) Of the above claim(s) 16-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 49-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/22)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

1. This action is in reply to applicant's correspondence of 09 November 2009.
2. Claims 49-64 are pending for examination.
3. Claims 49-64 are rejected.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09 November 2009 has been entered.

Requirement for Information

The applicant and the assignee requirement under 37 CFR 1.105 to provide a reply for information, insofar as the submitted information disclosures (IDS) of 10 March 2008 is concerned, has been noted.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a)

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shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 49-64 are rejected under 35 U.S.C. 102(e) as being anticipated by Downs et al, U.S. Patent 6,226,618 B1.

Prior Art's Broad Disclosure vs. Preferred Embodiments

6. As concerning the scope of applicability of cited references used in any art rejections below, as per MPEP § 1213, subsection R.5. Rejection Over Prior Art's Broad Disclosure Instead of Preferred Embodiments:

I. PATENTS ARE RELEVANT AS PRIOR ART FOR ALL THEY CONTAIN "The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain." In re Heck, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting In re Lemelson, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)). A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including nonpreferred embodiments. Merck & Co. v. Biocraft Laboratories, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989). See also > Upsher-Smith Labs. v. Pamlab, LLC, 412 F.3d 1319, 1323, 75 USPQ2d 1213, 1215 (Fed. Cir. 2005)(reference disclosing optional inclusion of a particular component teaches compositions that both do and do not contain that component);< Celeritas Technologies Ltd. v. Rockwell International Corp., 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998) (The court held that the prior art anticipated the claims even though it taught away from the claimed invention.). >See also MPEP § 2131.05 and § 2143, subsection X.D., which discuss prior art that teaches away from the claimed invention in the context of anticipation and obviousness, respectively.<

II. NONPREFERRED AND ALTERNATIVE EMBODIMENTS CONSTITUTE PRIOR ART
Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). "A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." In re Gurley, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994). Furthermore, "[t]he prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed...." In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

Downs et al *generally* teaches and suggests (i.e., Abstract, figures 1-16 and associated descriptions in general) the limitations set forth in the claims below.

7. As per claim 49; "A method, comprising:
reading digital content from a physical medium,
the digital content being encrypted

using a first encryption method [*Abstract, figures 1-16 and accompanying descriptions, and more particularly sections I-VI, VIII, IX, whereas the secure*

digital content electronic distribution system/methods utilization of separate secured content (' ... digital content being encrypted ... '), secured meta-data, secured licensing/metering and secured cryptographic parameters (' ... using a first encryption method ') & encryption/decryption key(s) communications between network node entities (i.e., content creators, distributors, licensing/metering clearinghouses, and users/user presentation, display and rendering devices) via the use of secured containers (SC), insofar as network distributed digital content is stored upon reception at the distributed destination network node (e.g., the user rendering and presentation point), clearly encompassing the claimed limitations, so comprised, as broadly interpreted by the examiner, and thereby not patently distinguishing the claim over the prior art.];

obtaining a content key

associated with said first encryption method [*Abstract, figures 1-16 and accompanying descriptions, and more particularly sections I-VI, VIII, IX, whereas the secure digital content electronic distribution system/methods utilization of separate secured licensing/metering and secured cryptographic parameters & encryption/decryption key (' obtaining a content key ... associated ... first encryption method ') communications between network node entities, distributors, licensing/metering clearinghouses, and users/user presentation, display and rendering devices via the use of SCs, clearly encompassing the claimed limitations, so comprised, as broadly interpreted by the examiner, and thereby not patently distinguishing the claim over the prior art.];*

decrypting said digital content

using said content key [*Abstract, figures 1-16 and accompanying descriptions, and more particularly sections I-VI, VIII, IX, whereas the secure digital content electronic distribution system/methods utilization of separate secured licensing/metering and secured cryptographic parameters & encryption/decryption key communications between network node entities (i.e., content creators, distributors ('decrypting said digital content ... using said content key '), licensing/metering clearinghouses, and users/user presentation, display and rendering devices) via the use of SCs, clearly encompassing the claimed limitations, so comprised, as broadly interpreted by the examiner, and thereby not patently distinguishing the claim over the prior art.*];
reencrypting said digital content

using a second encryption method [*Abstract, figures 1-16 and accompanying descriptions, and more particularly sections I-VI, VIII, IX, whereas the secure digital content electronic distribution system/methods utilization of separate secured licensing/metering and secured cryptographic parameters & encryption/decryption key communications between network node entities ('reencrypting said digital content ... using a second encryption method '), via the use of SCs, insofar as reencryption is associated with selectable cryptographic methods (e.g., sections II, V, VI, X), clearly encompassing the claimed limitations, so comprised, as broadly interpreted by the examiner, and thereby not patently distinguishing the claim over the prior art.*]; and
storing said digital content

after reencryption [*Abstract, figures 1-16 and accompanying descriptions, and more particularly sections I-VI, VIII, IX, whereas the secure digital content electronic*

distribution system/methods utilization of separate secured licensing/metering and secured cryptographic parameters & encryption/decryption key communications between network node entities, via the use of SCs, insofar as reencryption is associated with selectable cryptographic methods (e.g., sections II, V, VI, X), of which subsequent to said reencryption, the result is stored ('... storing said digital content ...') at the node that did the reencryption (e.g., at the register, memory, cache, HDD, etc., level at the least), clearly encompassing the claimed limitations, so comprised, as broadly interpreted by the examiner, and thereby not patently distinguishing the claim over the prior art.].”.

As per claim 62, this claim is the apparatus claim for the method claim 49 above, and is rejected for the same reasons provided for the claim 49 rejection.

As per claim 63, this claim is the means plus function claim for the method claim 49 above, insofar as the claim 63 locking, unlocking and re-locking correspond to the claim 49 encryption, decryption and re-encryption, and is rejected for the same reasons provided for the claim 49 rejection.

As per claim 64, this claim is the embodied software claim for the method claim 49 above, and is rejected for the same reasons provided for the claim 49 rejection.

8. Claim 50 **additionally** recites the limitation that; “The method of Claim 49, wherein additional digital content is received via at least one of:

- (a) a communication link, or
- (b) a physical medium from which the digital content can be read.”.

The teachings of Downs et al are directed towards such limitations (i.e., Abstract, figures 1-16 and accompanying descriptions, and more particularly sections IX-X, whereas the secure digital content electronic distribution system/methods utilization of separate content creators, distributors, secured licensing/metering and secured cryptographic parameters & encryption/decryption key communications between network node entities, licensing/metering clearinghouses, and users (' additional digital content is received ... a communication link ')/user presentation, display and rendering devices via the use of SCs, insofar as network distributed digital content is stored upon reception at the distributed destination ('... physical medium from which the digital content can be read ...') network node (e.g., the user rendering and presentation point), clearly encompassing the claimed limitations, so comprised, as broadly interpreted by the examiner, and thereby not patently distinguishing the claim over the prior art.).

9. Claim 51 *additionally* recites the limitation that; “The method of Claim 49, wherein said obtaining comprises:

- receiving a license comprising
- said content key; and
- decrypting said license
- using a device key
- associated with a particular device.”.

The teachings of Downs et al are directed towards such limitations (i.e., Abstract, figures 1-16 and accompanying descriptions, and more particularly sections IV-V, whereas the secure digital content electronic distribution system/methods utilization of separate secured licensing ('receiving a license ... content key ')/metering and secured cryptographic parameters & encryption/decryption key communications ('... decrypting said license ...') between network node entities via the use of SCs, clearly encompassing the claimed limitations, so *comprised*, as broadly interpreted by the examiner, and thereby not patently distinguishing the claim over the prior art.).

10. Claim 52 *additionally* recites the limitation that; "The method of Claim 49, wherein at least a portion of the license is received via at least one of:

(a) a communication link, or

(b) physical media from which the digital content can be read."

The teachings of Downs et al are directed towards such limitations (i.e., Abstract, figures 1-16 and accompanying descriptions, and more particularly sections IX-X, whereas the secure digital content electronic distribution system/methods utilization of separate content creators, distributors, secured licensing ('at least a portion of the license is received ... a communication link ')/metering and secured cryptographic parameters & encryption/decryption key communications between network node entities, licensing/metering clearinghouses, and users/user presentation, display and rendering devices via the use of SCs, insofar as network distributed digital content is stored upon reception at the distributed destination ('... physical medium from which the digital content can be read ...') network node (e.g., the user rendering

and presentation point), clearly encompassing the claimed limitations, so comprised, as broadly interpreted by the examiner, and thereby not patently distinguishing the claim over the prior art.).

11. Claim 53 *additionally* recites the limitation that; “The method of Claim 49, wherein the digital content represents

at least a portion of a media stream including at least one of:

animation;

sound;

still media;

pictures;

illustrations;

a database; or

another collection of information.”.

The teachings of Downs et al are directed towards such limitations (i.e., Abstract, figures 1-16 and accompanying descriptions, and more particularly sections I, VIII-X, whereas the secure digital content (e.g., pictures, movies, videos, music, etc.; '... a portion of a media stream including at least one of ...') electronic distribution system/methods utilization of separate content creators, distributors, secured licensing/metering and secured cryptographic parameters & encryption/decryption key communications between network node entities, licensing/metering clearinghouses, and users/user presentation, display and rendering devices via the use of SCs, clearly encompassing the claimed limitations, so comprised, as broadly interpreted by the examiner, and thereby not patently distinguishing the claim over the prior art.).

12. Claim 54 *additionally* recites the limitation that; “The method of Claim 49, further comprising:

obtaining a second content key
associated with said second encryption method;
decrypting said digital content
using said second content key
at a time of playback of said digital content.”.

The teachings of Downs et al are directed towards such limitations (i.e., Abstract, figures 1-16 and accompanying descriptions, and more particularly sections IV-V, VIII-X, whereas the secure digital content electronic distribution system/methods utilization of separate secured licensing (' obtaining a second content key ... second encryption method ')/metering and secured cryptographic parameters & encryption/decryption key communications between network node and users/user presentation, display and rendering devices ('... decrypting said digital content ... at a time of playback ... ') entities via the use of SCs, clearly encompassing the claimed limitations, so comprised, as broadly interpreted by the examiner, and thereby not patently distinguishing the claim over the prior art.).

13. Claim 55 *additionally* recites the limitation that; “The method of Claim 54, wherein the second content key is associated with
a particular device.”.

The teachings of Downs et al are directed towards such limitations (i.e., Abstract, figures 1-16 and accompanying descriptions, and more particularly sections IV-V, VIII-X, whereas the secure digital content electronic distribution system/methods utilization of separate secured licensing/metering and secured cryptographic parameters & encryption/decryption key communications between network node and users/user presentation, display and rendering devices ('... second content key is associated ... particular device ') entities via the use of SCs, clearly encompassing the claimed limitations, so comprised, as broadly interpreted by the examiner, and thereby not patently distinguishing the claim over the prior art.).

14. Claim 56 *additionally* recites the limitation that; "The method of Claim 55, wherein said obtaining said second content key comprises:

obtaining a license comprising

said second content key; and

decrypting said license

using a device key

associated with a secure portion of a presentation device."

The teachings of Downs et al are directed towards such limitations (i.e., Abstract, figures 1-16 and accompanying descriptions, and more particularly sections IV-V, VIII-X, whereas the secure digital content electronic distribution system/methods utilization of separate secured licensing (' obtaining a license ... second content key ')/metering and secured cryptographic parameters & encryption/decryption key communications between network node and users/user presentation, display and rendering devices ('... decrypting said license ... device key ...

associated with a secure portion ... device ') entities via the use of SCs, clearly encompassing the claimed limitations, so comprised, as broadly interpreted by the examiner, and thereby not patently distinguishing the claim over the prior art.).

15. Claim 57 *additionally* recites the limitation that; “The method of Claim 55, wherein said particular device comprises
a presentation device.”.

The teachings of Downs et al are directed towards such limitations (i.e., Abstract, figures 1-16 and accompanying descriptions, and more particularly sections IV-V, VIII-X, whereas the secure digital content electronic distribution system/methods utilization of separate secured licensing/metering and secured cryptographic parameters & encryption/decryption key communications between network node and users/user presentation, display and rendering devices ('... particular device ... presentation device ') entities via the use of SCs, clearly encompassing the claimed limitations, so comprised, as broadly interpreted by the examiner, and thereby not patently distinguishing the claim over the prior art.).

16. Claim 58 *additionally* recites the limitation that; “The method of Claim 49, wherein a license imposes restrictions on
presentation of a media stream.”.

The teachings of Downs et al are directed towards such limitations (i.e., Abstract, figures 1-16 and accompanying descriptions, and more particularly sections IV-V, IX-X, whereas the secure digital content (e.g., pictures, movies, videos, music, etc.; '... a media stream ...')

electronic distribution system/methods utilization of separate secured licensing ('restrictions ... presentation of a media stream ') /metering and secured cryptographic parameters & encryption/decryption key communications between network node entities (i.e., content creators, distributors, licensing/metering clearinghouses, and users/user presentation, display and rendering devices ('... presentation of a media stream ...') via the use of SCs, clearly encompassing the claimed limitations, so *comprised*, as broadly interpreted by the examiner, and thereby not patently distinguishing the claim over the prior art.).

17. Claim 59 *additionally* recites the limitation that; "The method of Claim 58, wherein the restrictions include at least one of

(a) a first date or time

at which presentation is allowed for the media stream,

(b) a last date or time

at which presentation is allowed for the media stream,

(c) a limit on the number of

presentations allowed for the media stream,

(d) a limit on the physical regions

in which presentation is allowed for the media stream,

(e) a requirement that a

charge, cost, or fee be paid, or

subscription be held

in order to allow presentation of the media stream,

- (f) a limit on the type of presentation device
permitted to present the media stream,
- (g) a limit on the output format
permitted to be used by the presentation device,
- (h) a limit on
the bit rate,
sampling rate, or
other measure of granularity or precision
permitted to be used by the presentation device.”.

The teachings of Downs et al are directed towards such limitations (i.e., Abstract, figures 1-16 and accompanying descriptions, and more particularly sections IV-V, IX-X, whereas the secure digital content electronic distribution system/methods utilization of separate secured licensing ('restrictions ... presentation of a media stream')/metering and secured cryptographic parameters & encryption/decryption key communications between network node entities (i.e., content creators, distributors, licensing/metering clearinghouses, and users/user presentation, display and rendering devices (e.g., pictures, movies, videos, music, etc.; '... restrictions include ... a limit on ...') via the use of SCs, clearly encompassing the claimed limitations, so *comprised*, as broadly interpreted by the examiner, and thereby not patently distinguishing the claim over the prior art.).

18. Claim 60 *additionally* recites the limitation that; “The method of Claim 49, wherein the license includes

an integrity code capable of revealing
whether that license has been tampered with.”.

The teachings of Downs et al are directed towards such limitations (i.e., Abstract, figures 1-16 and accompanying descriptions, and more particularly sections IV-V, VIII-X, whereas the secure digital content electronic distribution system/methods utilization of separate secured licensing/metering and secured cryptographic parameters & encryption/decryption key communications between network node and users/user presentation, display and rendering devices entities via the use of SCs, inclusive of the standard certificate integrity data structures (e.g., checksums, CRCs, etc.; '... integrity code ... revealing ... license has been tampered ... '), clearly encompassing the claimed limitations, so comprised, as broadly interpreted by the examiner, and thereby not patently distinguishing the claim over the prior art.).

19. Claim 61 *additionally* recites the limitation that; “The method of Claim 49, in which a license may be
revoked or replaced by
a new license.”.

The teachings of Downs et al are directed towards such limitations (i.e., Abstract, figures 1-16 and accompanying descriptions, and more particularly sections IV-V, VIII-X, whereas the secure digital content electronic distribution system/methods utilization of separate secured licensing/metering and secured cryptographic parameters & encryption/decryption key communications between network node and users/user presentation, display and rendering devices entities via the use of SCs, inclusive of the standard certificate management aspects (e.g.,

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license management, insofar as issuing as a function of compensation to use content, lease agreements, DRM aspects, etc.; '... license may be ... revoked or replaced ... new license '), clearly encompassing the claimed limitations, so comprised, as broadly interpreted by the examiner, and thereby not patently distinguishing the claim over the prior art.).

Conclusion

20. Any inquiry concerning this communication or earlier communications from examiner should be directed to Ronald Baum, whose telephone number is (571) 272-3861, and whose unofficial Fax number is (571) 273-3861 and unofficial email is Ronald.baum@uspto.gov. The examiner can normally be reached Monday through Thursday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edan Orgad, can be reached at (571) 272-7884. The Fax number for the organization where this application is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. For more information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ronald Baum

Patent Examiner

/R. B./

Examiner, Art Unit 2439

/Edan Orgad/

Supervisory Patent Examiner, Art Unit 2439